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Remarks

Claims 1-60 are pending in the application, of which claims 1-30 were rejected. New claims 31-60 were withdrawn from consideration as being directed to a non-elected invention based on the applicants' constructive election by original presentation. While the applicants respectfully traverse the restriction requirement, claims 31-60 have been canceled to advance the prosecution of the application.

Claims 1-30 were rejected under 3 U.S.C. 103(a) as being unpatentable over Ortega et al. ("Ortega") in view of Beach et al. ("Beach"). This rejection is respectfully traversed.

No Motivation to Combine

Ortega relates to searching a web site of an online merchant (e.g., Amazon.com) for items to purchase, not searching an entertainment system for available multimedia programs to be played. By contrast, Beach discloses an entertainment system that locally stores multimedia content (e.g., Tivo). However, Beach does not disclose or suggest providing a list of titles based on how frequently multimedia programs have been played, as required by claim 1.

There is no motivation to combine Amazon.com's merchandise search engine with Tivo's directory of locally-stored content. Amazon.com and Tivo have completely different purposes (online purchase vs. entertainment/playback) and operate on completely different "multimedia content" (items for purchase vs. stored television programs). In addition, Amazon.com is an online search engine accessed

remotely over the Internet, whereas Tivo is a digital video recorder (DVR) that locally caches television programs within a hard disk drive.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); see also MPEP § 2143. Even if all the elements of claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

The Examiner argues that the combination of Ortega and Beach results in a system for selecting multimedia programs within an entertainment system "in an efficient manner." Aside from the fact that neither reference mentions "efficiency," the Examiner's argument could be used to combine any two references, effectively voiding the motivation requirement. Every combination appears efficient when viewed in hindsight. However, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

In this case, the Examiner appears to be impermissibly using hindsight reconstruction based on the applicant's own teachings to "pick and choose" disparate elements of Amazon.com's search engine and Tivo's directory of locally-available

content. However, there must be some positive, concrete evidence (beyond mere efficiency) which gives a logical reason that justifies a combination of primary and secondary references. See In re Laskowski, 10 USPQ2d 1397 (Fed. Cir. 1989). Ortega and Beach simply do not suggest or provide motivation for the combination.

Combination Does Not Result In Claimed Invention

Even if the references were combined, the combination would not result in the claimed invention. Without relying on the applicant's invention as a roadmap to alter the purpose and meaning of such elements as "multimedia program," the Examiner is left with all of what the two references disclose, i.e., an online search engine with a popularity-based (not frequency of playback) listing and a separate local multimedia directory with an alphabetical or chronological listing. There is no teaching as to the desirability or even the possibility of replacing a search for purchasable items on Amazon.com with a search for locally-stored content on a Tivo DVR.

Ortega's Popularity Is Not "How Frequently a Media Program Has Been Played"

Ortega clearly defines "popularity" in terms of sales ranks or search frequency. This has nothing whatever to do with how often a multimedia program has been played. Ortega does not disclose playback of multimedia programs within any reasonable sense.

The Examiner has provided no rationale as to why popularity based on sales rank or search frequency is the same as frequency of playback. In the applicants' last response, several examples were provided (applicable to Tivo no less) in which

media programs may be played without having to be searched, e.g., playing from Tivo's Now Playing list. For example, I could perform only one search to locate a particular television show for recording. After that, I could watch the recorded program hundreds of times without having to perform another search. On the other hand, I could run multiple searches for a particular program that I actually watch only a few times (or possibly never). In other words, search frequency is not equivalent to playback frequency.

In response, the Examiner stated that none of these other methods for playback were disclosed in the claims. This misses the point. The question is not whether these other methods are disclosed in the claims, but whether the references teach what is being claimed. In this case, the references simply do not disclose or suggest keeping track of how often a media program has been played in order to provide a potential list of second words. Ortega may keep track of search frequency, but this is not what is being claimed.

Finally, Ortega's popularity is based on "the most frequently accessed items among a population of users." A plurality of geographically diverse users each access the Amazon.com web site through their own individual computer systems. If the display of an item to be purchased, such as a music CD, could be analogized to multimedia playback (which it cannot), such playback would occur on different computer systems.

However, claim 1 recites providing a potential list of second words based on "how frequently a multimedia program whose name includes one of the second words has been played by the entertainment system" (not a plurality of different

computer systems). Thus, Ortega's concept of popularity based on multiple Internet users actually teaches away from the claimed invention.

In view of the foregoing, the applicant respectfully submits that claims 1-30 are in condition for allowance. In the event that the Examiner disagrees, the applicant respectfully requests that the Examiner enter the amendment to place the claims in better condition for appeal.

Respectfully submitted,

Digeo, Inc.

By


Kory D. Christensen
Registration No. 43,548

STOEL RIVES LLP
One Utah Center Suite 1100
201 S Main Street
Salt Lake City, UT 84111-4904
Telephone: (801) 328-3131
Facsimile: (801) 578-6999

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